

REMARKS

The Office Action dated September 27, 2006, has been received and carefully considered. In this response, claims 1, 13, and 22 have been amended. Entry of the amendments to claims 1, 13, and 22 is respectfully requested. Reconsideration of the outstanding rejections in the present application is also respectfully requested based on the following remarks.

I. THE DOUBLE-PATENTING REJECTION OF CLAIMS 1-26

On page 2 of the Office Action, claims 1-26 were rejected under the judicially created doctrine of obviousness-type double-patenting as being unpatentable over claims 1-20 of U.S. Patent No. 6,899,714.

To expedite the prosecution of the present patent application toward finality, this rejection is hereby respectfully traversed with the filing of a terminal disclaimer concurrently herewith. It should be noted, however, that the filing of a terminal disclaimer in the present patent application does not constitute an admission of the propriety of the obviousness-type double-patenting rejection. See MPEP § 804.02 and Quad Environmental Technologies Corp. v. Union Sanitary District, 946 F.2d 870, 20 USPQ2d 1392 (Fed. Cir. 1991).

In view of the foregoing, it is respectfully requested that the aforementioned double-patenting rejection of claims 1-26 be withdrawn.

II. THE DOUBLE-PATENTING REJECTION OF CLAIMS 1-26

On page 2 of the Office Action, claims 1-26 were rejected under the judicially created doctrine of obviousness-type double-patenting as being unpatentable over claims 1-14 of U.S. Patent No. 7,087,056.

To expedite the prosecution of the present patent application toward finality, this rejection is hereby respectfully traversed with the filing of a terminal disclaimer concurrently herewith. It should be noted, however, that the filing of a terminal disclaimer in the present patent application does not constitute an admission of the propriety of the obviousness-type double-patenting rejection. See MPEP § 804.02 and Quad Environmental Technologies Corp. v. Union Sanitary District, 946 F.2d 870, 20 USPQ2d 1392 (Fed. Cir. 1991).

In view of the foregoing, it is respectfully requested that the aforementioned double-patenting rejection of claims 1-26 be withdrawn.

III. THE ANTICIPATION REJECTION OF CLAIMS 1-9 AND 13-26

On page 3 of the Office Action, claims 1-9 and 13-26 were rejected under 35 U.S.C. § 102(e) as being anticipated by Goble et al. (U.S. Patent No. 6,620,195). This rejection is hereby respectfully traversed.

Under 35 U.S.C. § 102, the Patent Office bears the burden of presenting at least a prima facie case of anticipation. In re Sun, 31 USPQ2d 1451, 1453 (Fed. Cir. 1993) (unpublished). Anticipation requires that a prior art reference disclose, either expressly or under the principles of inherency, each and every element of the claimed invention. Id. "In addition, the prior art reference must be enabling." Akzo N.V. v. U.S. International Trade Commission, 808 F.2d 1471, 1479, 1 USPQ2d 1241, 1245 (Fed. Cir. 1986), cert. denied, 482 U.S. 909 (1987). That is, the prior art reference must sufficiently describe the claimed invention so as to have placed the public in possession of it. In re Donohue, 766 F.2d 531, 533, 226 USPQ 619, 621 (Fed. Cir. 1985). Such possession is effected only if one of ordinary skill in the art could have combined the disclosure in the prior art reference with his/her own knowledge to make the claimed invention. Id.

Regarding claim 1, the Examiner asserts that Goble et al. discloses the claimed invention. Applicant respectfully disagrees. Specifically, Applicant respectfully submits that

Goble et al. fails to disclose, or even suggest, a first end of a connecting screw configured to be substantially transversely received by and threadingly engaged with the engaging portion of a vertebral screw within the vertebral body of a vertebra, as presently claimed. Instead, Goble et al. discloses that transverse pin 200 merely passes through region 130/135 of bone screw 100A. Accordingly, is it respectfully submitted that claim 1 is allowable over Goble et al..

Regarding claims 2-9, these claims are dependent upon independent claim 1. Thus, since independent claim 1 should be allowable as discussed above, claims 2-9 should also be allowable at least by virtue of their dependency on independent claim 1. Moreover, these claims recite additional features which are not disclosed, or even suggested, by the cited references taken either alone or in combination.

Regarding claims 13 and 22, these claims recite subject matter related to claim 1. Thus, the arguments set forth above with respect to claim 1 are equally applicable to claims 13 and 22. Accordingly, is it respectfully submitted that claims 13 and 22 are allowable over Goble et al. for the same reasons as set forth above with respect to claim 1.

Regarding claims 14-20 and 23-26, these claims are dependent upon independent claims 13 and 22, respectively. Thus, since independent claims 13 and 22 should be allowable as

discussed above, claims 14-20 and 23-26 should also be allowable at least by virtue of their dependency on independent claims 13 and 22. Moreover, these claims recite additional features which are not disclosed, or even suggested, by the cited references taken either alone or in combination.

Regarding claim 21, the Examiner asserts that Goble et al. discloses the claimed invention. Applicant respectfully disagrees. Specifically, Applicant respectfully submits that Goble et al. fails to disclose, or even suggest, a bore screw having a shaft and a threaded portion, wherein the bore screw is configured to bore an opening in a vertebra for placement of a pedicle screw, as claimed. Indeed, Goble et al. fails to disclose any type of bore screw, let alone a bore screw that is configured to bore an opening in a vertebra for placement of a pedicle screw, as claimed. Accordingly, is it respectfully submitted that claim 21 is allowable over Goble et al..

At this point Applicants would like to remind the Examiner that, as stated in MPEP § 2131, "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." Verdegaal Bros. v. Union Oil Co. of California, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

In view of the foregoing, it is respectfully requested that the aforementioned anticipation rejection of claims 1-9 and 13-26 be withdrawn.

IV. CONCLUSION

In view of the foregoing, it is respectfully submitted that the present application is in condition for allowance, and an early indication of the same is courteously solicited. The Examiner is respectfully requested to contact the undersigned by telephone at the below listed telephone number, in order to expedite resolution of any issues and to expedite passage of the present application to issue, if any comments, questions, or suggestions arise in connection with the present application.

To the extent necessary, a petition for an extension of time under 37 CFR § 1.136 is hereby made.

Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account No. 50-0206, and please credit any excess fees to the same deposit account.

Respectfully submitted,

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